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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,417	01/17/2002	David Harrow Gelfand	1803-0329-999	4095

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EXAMINER

SITTON, JEHANNE SOUAYA

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Information Disclosure Statement

1. The IDS filed 2/19/2003 has been considered although the Hungarian publications have not. An Explanation of Relevance Under 37 CFR 1.98(3)(i) was filed explaining that the publications claimed priority to US patents. This has been considered, however without any information as to what parts or information of each publication was or was not disclosed in the respective US patents, the examiner cannot make any judgment as to the content of the Hungarian publications as no translation or explanation as to how the content of the Hungarian publications (for example, are the US patents literal translations? Do the Hungarian publications disclose more information and if so, what is it?) and the respective US patents compare have been submitted.

Response to Declaration

2. The declaration under 37 CFR 1.132 filed 1/3/2003 is sufficient to overcome issues under 35 USC 112, first paragraph raised in the parent application 09/146,631. The declaration shows that polymerases with the amino acid at position 4 of the critical motif other than Glu have a level of discrimination against incorporation of nucleotides labeled with fluorescein family dyes which is reduced in comparison to polymerases that have a mutation at position 46 which attenuates the 5' nuclease activity of the polymerase (see figure 1). The declaration states that this mutation at position 46 does not affect the incorporation of fluorescein family dyes and should not have an effect on a mutation at position 4 of the critical motif.

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Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,346,379. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are in most cases broader than the claims of the '379 application, however the claims of the instant application are obvious over the claims of the '379 patent and are coextensive in scope. The courts have stated that a genus is obvious in view of the teaching of a species. See *Slayter*, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); and *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989). Therefore the instantly claimed polymerase with any mutation at position 4 of the critical motif other than Glu is obvious in view of the patent claims' to a specific mutation (lys) at position 4.

Conclusion

4. No claims are presently allowable.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Sitton whose telephone number is (571) 272-0752. The examiner can normally be reached Monday-Thursday from 8:00 AM to 5:00 PM and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272-0745. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (571) 272-0507.



Jehanne Sitton
Primary Examiner
Art Unit 1634

6/8/04